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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dean Furbush

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3695

NOTIFICATION DATE

DELIVERY MODE

03/22/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	09/903,388	FURBUSH ET AL.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 29-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 29-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication of December 1, 2010. Amendments made in that communication have been entered. Election/restriction requirement is withdrawn by the examiner in view of the Petition decision rendered on December 23, 2010. Claims 1-17 and 29-49 are pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 and 33-39, 41-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites the limitation "the order of a type that is executable against any participant that can at least in part satisfy at least a portion of the specified quantity of the order" is interpreted as non-functional descriptive material because it only describes the order. It does not in any material way affect the step of entering the order. There is nothing in the cited limitation that shows how the entering step is altered as a result of the description of the order. This claim further recites the limitation "the graphical user interface allowing the user to form the order and the graphical user interface including a field that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue" is interpreted as non-functional descriptive material because it only describes the information in the graphical user interface (GUI). It does not in any material way affect the step of the display

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rendering a graphical user interface. There is nothing in the limitation that further limits how the graphical user interface is rendered. Also the metes and bounds of the limitations “allowing the user to form the order” and “that allows the user to choose” are unclear. Specifically it is not clear as to what is the result of allowing the user to form the order. Is the order formed or is it not? Similar reasoning applies to allowing the user to choose. Allowing a user to perform a function does not necessarily imply that the function is performed. Dependent claims are rejected by way of dependency on a rejected claim.

Claim 2 recites “wherein the client system is coupled to a network” and “a server system coupled to the network”. It is not clear if the network is a part of the claimed system. Hence the scope of the claim is unclear. This claim also recites “The system of claim 1 wherein the client system is coupled to a network, the system further comprising a server system”. It is not clear as to which system further comprises a server system. Is it the client system or the “main” system in claim 1.

Claims 8-16 recite the limitations “the server” or “the server system”. These limitations lack antecedent basis.

Claim 33 recites the limitation “The computer program product of claim 29 further comprising instructions to cause a computer to”. It is not clear if the computer in this claim is the same computer in claim 29. Also as discussed in claim 1 above the limitation “the graphical user interface including a field that allows a user to form the order and to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue” is not further limiting on the claim.

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Claim 34 recites the limitation “The client system including a display” and “choosing by the client computer system”. The Examiner has interpreted both these systems to be “the client computing system”.

Claims 34-39 claim a method but recite the features of a system (e.g. the client system including a display that renders a graphical user interface including a field for providing a priority type for how the order interacts with contra side quotes/orders in the trading venue). Claims 34-39 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of a system. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm.* Dependent claims 35-39 are rejected based on similar reasoning and by way of dependence on a rejected independent claim.

Claim 41 recites “The system of claim 40 wherein the specified priority is that the order executes against contra side interest in price/time priority, and the system is further configured to”. It is not clear which system the Applicants are referring to. There are three different systems mentioned in claim 40. Claims 42-44 suffer from similar ambiguities.

Claims 45-49 recite “A computer program product for an electronic trading venue”. It is not clear if the computer program product is a tangible or intangible product. The Examiner has broadly interpreted the computer program product to include an intangible product.

Appropriate correction is required for all these claims.

The art rejections below are interpreted in view of the 112, second paragraph rejections above.

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Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 34-39 and 45-49 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a “**new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof**” (emphasis added).

Claims 34-39 are intended to embrace or overlap two different statutory classes of invention as set forth in 35 § U.S.C. §101. “A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548).

Claims 45-49 recite “A computer program product for an electronic trading venue”. The Examiner has broadly interpreted the computer program product to include an intangible product. Intangible products are patent ineligible under 35 USC 101.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1, 2, 5, 17, 29, 31-34, 37, 40, 44, 45 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over May (US Pub No. 2002/013890 A1).

Claim 1 May teaches a system for an electronic venue for trading of securities comprising: a client system for entering an order to buy or sell a specified quantity of a security, the order of a type (buy and sell are the order types) that is executable against any participant that can at least in part satisfy at least a portion of the specified quantity of the order (See the entire disclosure of May particularly Figure 2, 14-A); the client system including: a computing system (See the entire disclosure of May particularly Figure 2); a display coupled to the computing system (See the entire disclosure of May particularly Figure 2), the display rendering a graphical user interface, the graphical user interface allowing the user to form the order and the graphical user interface including a field that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 273-276, 283-285, the good until option is an example of order priority type).

Claim 2, Official notice is taken that the feature wherein the client system is coupled to a network, the system further comprising: a server system coupled to the network that receives the order from the client system and executes the order against interest in the trading venue based on the priority type chosen by the user is old and well known. For instance when a market order is sent the system recognizes the order and executes it immediately at the prevailing market price. If it is a limit order the order is filled only when that price is reached. Using the client-server system makes the process of execution cost efficient and timely.

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Claim 29, May teaches a computer program product for an electronic trading venue for trading of securities said computer program product tangibly embodied on a computer readable medium comprising instructions for causing a computer to (See the entire disclosure of May particularly Paragraphs 31-32): receive an order entered from a client system, the order to buy or sell a specified quantity of a security, the order of a type that is executable for execution against any participant that can at least in part satisfy at least a portion of the specified quantity of the order (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 278, 288-290, 340, 358, 369-371); and determine from the received order a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of May particularly Figures 2, 6-9B, 14A-B, Paragraphs 39-58, 72, 111-115, credit preference is interpreted to include order priority type); and execute the order against contra-side interest according to the determined priority type (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 278, 288-290, 340, 358, 369-371).

Claim 33, May discloses the feature of generating a graphical user interface, the graphical user interface including a field that allows a user to form the order and to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of May particularly Figures 2, 6-9B, Paragraphs 39-58, 72, 111-115, credit preference is interpreted to include order priority type).

Claim 34, May teaches a method for trading of securities in an electronic trading venue, the method comprises: entering at a client computing system an order executable against any participant that can at least in part satisfy the order, the client system including a display that renders a graphical user interface including a field for providing a priority type for how the order

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interacts with contra side quotes/orders in the trading venue; and choosing by the client computer system populating the field in the graphical user interface rendered on the display a priority type for how the order interacts with contra side quotes/orders in the trading venue (Please see rejection of claim 1).

Claim 40, May teaches a system for trading of securities in an electronic trading venue, the system comprises: a computer system configured to receive from a client system that displays a graphical user interface, an order executable against any participant that can at least in part satisfy the order, with the order having a user-selectable field specifying a priority type for how the order interacts with contra side quotes/orders in the market (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 278, 288-290, 358, 369-371); and execute the order against contra side orders in the trading venue in accordance with the priority type specified by the order (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 273-278, 288-290, 358, 369-371). The limitation “a client system that displays a graphical user interface” is interpreted as an intended use of the client system without any bearing on how the order is received or executed by the computer system. Hence this limitation is not given patentable weight.

Claim 45, May teaches a computer program product for an electronic trading venue for trading of securities said computer program product residing on a computer readable medium comprising instructions for causing a computer to (See the entire disclosure of May particularly Paragraphs 31-32): receive from a client system that displays a graphical user interface, an order executable against any participant that can at least in part satisfy the order, with the order specifying a priority type for how the order interacts with contra side quotes/orders in the market

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(See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 278, 288-290, 358, 369-371); determine from the order the priority type specified by the order (See the entire disclosure of May particularly Figures 2, 6-9B, 14A-B, Paragraphs 39-58, 72, 111-115, credit preference is interpreted to include order priority type); and execute the order against contra side orders in the trading venue in accordance with the priority type specified by the order (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 267, 278, 288-290, 340, 358, 369-371). The limitation “a client system that displays a graphical user interface” is interpreted as an intended use of the client system without any bearing on how the order is received or executed by the computer system. Hence this limitation is not given patentable weight.

Claims 17, 32, 44 and 49 May teaches the feature wherein the order is a non-directed order, which is an order that is not directed to any particular participant (Implied in the disclosure of May).

Claims 5, 31, and 37, May discloses the feature wherein one of the priorities is that the order executes against displayed contra side interest in price/time priority (See the entire disclosure of May particularly Paragraphs 284, 299, 315)

8. Claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over May (US Pub No. 2002/013890 A1) in view of NASD Rulemaking Reference (Reference U in PTO-892 mailed March 18, 2008).

Claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48, May teaches a system, a computer program product and a method of claims 1, 29, 34, 40 and 45 respectively as discussed above.

May does not explicitly teach the features included in claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48.

Reference U teaches the features in these claims (See the disclosure of Reference U). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the features taught by Reference U to the invention of May. The motivation to combine is that the combined system will bring together a broad range of participants into a single, integrated electronic system that will maximize the role of each participant to the ultimate benefit of all participants in the Nasdaq Stock Market as a whole - individual and institutional investors, order-entry broker-dealers, market makers, and ECNs (See page 2 of Reference U).

Response to Arguments

9. Applicant's other arguments have been fully considered but they are either moot in view of new grounds of rejection or are not persuasive.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the attached form PTO-892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished

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applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner,
Art Unit 3695

March 14, 2011